

**REMARKS**

Reconsideration is respectfully requested.

Claims 1 and 4 through 26 remain in this application. Claims 2 and 3 have been cancelled. No claims have been withdrawn. Claim 27 has been added.

Claims 1 through 26 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sands in view of Scheuring.

Turning first to the "Response to Arguments" portion of the final Office Action, it is stated that:

First, applicant contends that there is no motivation to combine the caller ID unit and the telephone both elements included in the Sands reference. Both are at the users premise and to put the two together would be obvious to one of ordinary skill in the art and not patentable. This is in particularly true in light of the Scheuring et al. reference where a caller identifying means is included in the user's customer premise equipment (CPE) (see Fig. 1 and steps 420 and 430 in Fig. 4). In fact, the examiner could call the phone and caller ID unit in Sands the CPE.

It appears that the reasoning set forth here is that, since one could conceptually combine these two devices, then one of ordinary skill in the art must find it obvious to do so. Simply because the Sands device and the Scheming device might both be present on a "user's premise" does not establish that a combination of the two would necessarily be "obvious". Contrary to the position in the Office Action that such a combination *could* be done, it is respectfully submitted that one of ordinary skill in the art would not find it obvious to combine the dynamic call waiting phone system of Sands into a telephone based upon what the prior art *actually* teaches. Sands is directed to a telephone system comprising a dynamic call waiting system based on caller ID in which calls are routed based on the calling number, and are, for example, routed to voicemail, a forwarding number or scheduled for a call back (Sands, Abstract). The Sands patent in actuality

clearly teaches one of ordinary skill in the art that the caller ID unit of the Sands system is separate from the telephone, and thus it is submitted that such an allegedly obvious modification of Sands is contrary to the teaching of Sands. For example, Figures 1 and 2 of the Sands patent clearly and unambiguously show the "caller ID unit" 22 (in Figure 1) and 60 (in Figure 2) as a separate and distinct element from the telephone 20 (in Figure 1) and 52 (in Figure 5). It is submitted that there is a clear delineation between these elements in the drawings figures that one of ordinary skill in the art would recognize are distinct elements. (Also note that the telephone 20 and 52 are depicted with a drawing of a telephone, and not simply as another block in the block diagram of these figures, which further leads one of ordinary skill in the art to understand that telephone 20 and 52 is not just simply another element of the overall invention, but a distinct environmental element.) Thus, the speculation that these elements *could* be combined does not find any support in the prior art itself.

Further, Sands states at col. 1, lines 56 through 59 that (emphasis added):

Dynamic call waiting based on the caller's ID is carried out under the control of a microprocessor located either in a subscriber's caller ID unit or at a telephone network processing center.

Thus, the Sands patent describes the functionality being carried out by a microprocessor in two locations—neither being in the user's telephone.

Also, Sands states at col. 2, lines 55 through 58:

Caller ID unit 22 is a remote device located with the first telephone terminal 12, commonly referred to as customer premises equipment (CPE).

Thus, the caller ID unit of Sands is described as being used with "customer premises equipment", and not as part of any customer premises equipment or telephone terminal. Still further, Sands describes the caller ID unit at col. 3, lines 7 through 53 as having a number of elements (e.g., speaker) that duplicate those found in a telephone, and describe features (e.g., voice

recognition) that are not typically found in a conventional telephone. Thus, it is submitted that these teachings of the Sands patent cannot be ignored so that it can be said that Sands is "unclear" as to whether the caller ID unit is part of a telephone, as the question is what would one of ordinary skill in the art understand from the art.

Further, with respect to the assertion that "the examiner could call the phone and caller ID unit in Sands the CPE", it is submitted that such an assumption would go beyond what Schuering teaches, as Schuering does not disclose that the CPE mentioned in Schuering encompasses both a phone and a caller ID unit. Simply because the term "customer premises equipment" is a fairly broad term does not mean that the term necessarily discloses or suggests to one of ordinary skill in the art any equipment that might be found on the customer's premises.

It is further argued in the "Response to Arguments" portion of the final Office Action that:

Second, it is argued that there is nothing in Sands, which would allow one to carry on a telephone conversation as well as schedule, by the user a callback based on identified call information. However, the instant claims are not written in such a way as to convey such an idea. For example, claim one is written in such away that it does not convey that the calling party stays on the line while the scheduling is going on. How does continuing the call relate to the scheduling means? For instance, does the system have a voice recognition system so during the call when a user says I will have to call you back at 5 O'clock tomorrow the system calls up the scheduling program and without anything more and schedules the call? If so, such is not claimed.

With respect to the above statement, the remarks of the previous response referred to in the "Response to Arguments" were not intended to distinguish the claimed invention over the Sands or Scheuring, but to point out the incompatibilities between the systems of the Sands and Schuering patents that the Patent Office is suggesting that one of ordinary skill in the art would find "obvious" to combine. Thus, that portion of the remarks is directed to the "obviousness" of the combination to one of ordinary skill in

the art, and not directed to differentiating the claimed invention from the prior art. As previously noted, the assertion is made in the rejection that incorporating the “scheduling means as taught by Scheuring et al. into the Sands system as such would only entail the substitution of one scheduling means for another”, it is submitted that the switch of the elements in the Scheuring system for the elements in the Sands system is not merely “entail the substitution of one scheduling means for another”. It is noted that the Sands patent states at col. 6, lines 46 through 54 that (emphasis added):

If at step 156, it is determined not to provide a busy tone to the calling party, the program proceeds to step 160 to determine if a call back service is to be provided when the called party is available. If at step 160 it is determined to provide the call back service, the service provider at step 162 schedules a call back to the called party when the called party's line is no longer busy. The call waiting call is then ended at step 154.

Thus, the Sands system includes an element that schedules a call back that is scheduled when the “called party’s line is no longer busy” (e.g., becomes available). Since the program cannot know how soon or at what point the line will become free, this “scheduling” cannot comprise a specific time, but is keyed to the event that the called party’s line is no longer busy. In contrast, the Scheuring patent application discusses a system in which the caller is provided with the option of choosing a specific time for a call back depending upon “scheduled events” in the user’s calendar, and thus is based upon constraints of the called party’s schedule, but not necessarily when the called party’s line is no longer busy. See, e.g., Scheuring at ¶0078, which states:

[0078] If it is determined (480) to give the caller an option to schedule a callback based on time shown for the caller in the user's portrait database 132 and the user's availability based on scheduled events in the user's calendar, scheduling information is received (490) from the caller via touchtone input or voice recognition and then the calendar database 117 is updated (495). In addition, the caller may also leave a voicemail. If the caller is not given the option to schedule a callback, the caller may leave a voicemail, which is recorded (485) and stored in stored voicemails 139. The method 400 then ends.

Thus, the Scheuring system is submitted to take a significantly different approach to scheduling the callback, relying instead on the user's schedule to set a time for a callback, rather than simply scheduling a callback for when the called party's line is free, as in Sands.

It is therefore submitted that the allegedly obvious modification of the Sands system with the Scheuring system is not merely "substituting one scheduling means for another", as asserted in the rejection of the final Office Action. Thus, it is believed that the cited patents, and especially the allegedly obvious combination of Sands and Scheuring set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 10 and 15. Further, claims 2 through 7 and 21 through 24, which depend from claim 1, claims 11 through 14 and 25 and 26, which depend from claim 10, and claims 16 through 20, which depend from claim 15, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

It is further alleged in the final Office Action that:

The instant claims are so broad as read on the following scenario: a user is called on a system having VoIP and caller ID (like Internet call waiting), the user while talking clicks his calendar and schedules a date and time to call the caller back. There is not even a limitation that the instant claim 1 recites that says that at the appointed date and time the system automatically calls back the earlier calling party.

It is noted that the claims have been amended, and it is submitted that this statement is not true with respect to the claims, particularly as they have been amended.

It is further contended in the Office Action that:

Applicant also argues that Sands does not allow one to schedule a callback after receiving the call, however this is not entirely true. Even in Sands the callback is not scheduled until after receiving the call. The call is received and the identified and then scheduled for a callback or some other routing like to voicemail. Even if applicant

were to prevail on this point, the examiner was looking at the calendaring system in Scheuring et al, which allows for such an option. Again the claims are broad and in some cases ambiguous.

It appears that this statement is directed to the comments in the last response that are directed to claims 10, 15, 22, and 23, among others. Claim 10 requires, in part “providing the caller information associated with the incoming telephone call through the first device to a recipient of the incoming call” and “enabling the recipient of the incoming call to optionally select, *after receiving the incoming call*, initiation of automatic scheduling of a call-back for the incoming telephone call, using the first device, *based on the caller information provided to the recipient*”. Further, claim 15 requires, in part, “means for presenting the identifying information to a recipient of the incoming communication” and “means for enabling the recipient of the incoming communication to optionally select, *after receiving the incoming communication and presentation of the identifying information*, initiation of automatic scheduling of a response to the incoming communication *based on information identified by said identifying means*”. Claim 22 requires “wherein the scheduling means enables a user of the portable device, after receiving the incoming call, to, at the option of the user, automatically schedule a call-back”. Claim 23 requires “wherein the scheduling means enables a user of the first device, to, at the option of the user and based on a selection by the user after receiving the incoming call, automatically schedule a call-back”. Again, none of these requirements were specifically addressed in the rejection of the Office Action, and it is submitted that the allegedly obvious combination of Sands and Scheuring would not lead one of ordinary skill in the art to these requirements. It appears that the language of claim 1 is only being compared to the cited patents, without regard to the more specific requirements in these claims.

More specifically, and in contrast to the present invention in which, after receiving a telephone call, the user can select to schedule a call back,

the Sands patent discusses a call waiting system in which a scheduled call back is stored, i.e., selected, prior to receiving a telephone call. In other words, a user of the Sands system can select to activate a call back feature prior to receiving a telephone call but not after. Further, in Sands, it is the dynamic caller ID system, illustrated, for example by step 160, which determines if a call back service is to be used when the called party is unavailable. If so, the service provider, at step 160, schedules a call back to the called party when the called parties line is no longer busy (Sands, col. 6, lines 46-53 and Figure 6). Therefore, it is the phone system in Sands which does the initiation of automatic call back based on a previous instruction of a user prior to a call being initiated.

Conversely, in the present invention as claimed in claim 23, the user makes the selection to schedule the call back after receiving the phone call, not prior to receiving the phone call. For the foregoing reasons it is respectfully submitted that, Sands does not teach or suggest claim 23.

With regard to claims 10 through 13 and 15 through 18 and 23, as well as added claims 24 through 26, the claims require that the recipient of an incoming communication optionally selects, after receiving an incoming call, to initiate automatic scheduling of a response. As discussed above with regard to claim 23, Sands fails to teach or suggest an arrangement wherein a recipient, after receiving an incoming communication, selects and initiates automatic scheduling of a response. Instead, Sands merely teaches that a recipient, prior to receiving an incoming call, sets up an automatic call back feature. Nowhere does Sands teach or suggest a user selecting, after receiving an incoming call, initiation of automatic scheduling as claimed. Moreover, it is respectfully submitted that Sands does not teach or suggest that a recipient of a call would or could make any determination with respect to, or provide initiation of, automatic scheduling of a call back by the recipient in response to an incoming call. Sands merely teaches an

automated system which may schedule a call back if a recipient, prior to receiving an incoming call, has configured the system accordingly.

It is submitted that the aforescribed distinction between the requirements of the claims and the teaching of Sands is significant, as the Sands system is operative only with respect to phone numbers previously entered in the database and previously indicated as being

Also, as noted above, the remarks of the final Office Action continue to contend that Sands teaches a caller ID unit for identifying caller information associated with an incoming call (citing Sands, Figure 5), but it is conceded that that Sands device does not include a caller ID device that is integrated into the same device as the phone of the Sands device. It is then asserted that:

With respect to the caller ID means it would have been obvious to one of ordinary skill in the art to have incorporated the caller ID device into the phone 12 as such only entail putting two separate devices used together and incorporating them into one device.

With respect to the allegation that it would have been obvious to one of ordinary skill in the art to incorporate the caller ID unit into the phone 12 as such would only entail putting two separate devices used together and incorporating them into one device, it is submitted that the allegedly obvious combination of a caller ID unit and a telephone is not an obvious modification of the Sands system. Sands describes a system whose functions go beyond merely providing caller ID information to the user of the telephone, and includes a number of functions in addition to conventional "caller ID". Specifically, the disclosed dynamic call waiting system functions to route calls while a user is using a telephone. It is submitted Sands fails to provide any enabling disclosure which would allow one of ordinary skill in the art to modify a telephone so that the telephone would function as a telephone for carrying on a telephone conversation as well as to function to re-route incoming telephone calls in accordance with



the disclosed dynamic call waiting system which is incorporated in a telephone network, i.e., dynamic call waiting system 10, remote from a telephone connected to the system. Since Sands fails to enable one of ordinary skill in the art to produce the present invention as claimed in claim 1 which recites, *inter alia*, scheduling means disposed in a first device which enables one to speak to an initiator of an incoming call, and schedule, by the user, a call back based on an identified caller information, claim 1 is not obvious in view of Sands.

Withdrawal of the §103(a) rejection of claims 1 and 4 through 26 is therefore respectfully requested.

### CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



Jeffrey A. Proehl (Reg. No. 35,987)  
Customer No. **40,158**  
P.O. Box 5027  
Sioux Falls, SD 57117-5027  
(605)336-3890 FAX (605)339-3357

Date:

FEB 5, 2007